

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group I, Claims 1-27 and 38-56, and reserve the right to file a divisional application directed to the non-elected subject matter of the remaining claims in this application.

However, Applicants respectfully traverse the present restriction requirement and request reconsideration of this restriction requirement in view of the following remarks.

It was previously held that claims sharing common subject matter which merely provide additional limitations to perfect the basic inventive concept are therefore so interwoven as to constitute a single invention to be examined together. See, In re Application of Leber, Decision on Petition, filed July 20, 1987, Serial No. 902,864, published in PRI opinions on December 3, 1990; a copy of which is attached herein. In the present case, all of the claims of the present invention share common subject matter related to detecting the presence of one or more analytes in a biological sample, either by a method or an analytical test device. Applicants further respectfully submit that Groups I and II should be examined together since they are both classified in the same class, Class 435.

In view of this, Applicants respectfully submit that all of Claims 1-56 share common subject matter, the "Groups" are not distinct, and the present restriction requirement is improper. Thus Applicants respectfully request that the present restriction requirement be withdrawn.

It should also be observed that a requirement for restriction is not mandatory under either 35 U.S.C. §121 or 37 C.F.R. §1.142, it is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 USPQ 98 (E.D. Va. 1966), aff'd, 374 F. 2d 511, 153 USPQ 91 (4th Cir. 1967). In addition, the courts have recognized the advantages to the public interest to permit a patentee to claim all aspects of its invention, as the Applicants have done herein, so as to encourage the patentee to make a more detailed disclosure of all aspects of its discovery. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in a manner required by 35 U.S.C. §113 all aspects of what they regard as their invention; regardless of the number of statutory classes involved. In re Kuehl, 177 USPQ 250, 256 (CCPA 1973). (Emphasis added).

Furthermore, Applicants respectfully suggest that in view of the continued increases of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional intent to promote and encourage the progress of science and the useful arts.

It is believed that this Response has been submitted in timely fashion to the U.S. Patent and Trademark Office. However, the Assistant Commissioner is hereby authorized to charge any fees which may be necessitated by the filing of this Response to Deposit Account No. 02-1666.

Applicants further respectfully note, in response to the Official Action of January 13, 2003, that according to Applicants' records, it is Applicants' understanding that a full and complete bona fide response was timely sent to the Patent Office on October 21, 2002. A complete copy of this response is in Applicants' file. However, in order to be in full compliance with the present Official Action of January 13, 2003, Applicants have presented herewith the instant Response.

Thus, it is again respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bruce S. Weintraub", with a stylized flourish at the end.

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